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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,657	01/23/2002	Mary E. Goulet	CK 4154	5506

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EXAMINER	
BORISSOV, IGOR N	

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/052,657	GOULET ET AL.	
	Examiner	Art Unit	
	Igor Borissov	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *03* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,5,10 and 15-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,5,10 and 15-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 2-4, 6-9 and 11-14 have been canceled without prejudice. New **claims 21-22** have been added. **Claims 1, 5, 10 and 15-22** are currently pending in the application.

Claim Rejections under 35 USC § 112 have been withdrawn due to the applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 10, 15-17 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narang (US 2001/0025296 A1) in view of Sherman et al. (US 2002/0051119 A1).

Narang teaches a method and system for creation a music work over a computer network, comprising:

Claim 1. Posting artistic works, including screenplays, plays and musical scores for musical works on the Internet; receiving the implementations of the project from the members [0007]; [0009].

Narang does not specifically teach that said posted artistic works include *audio-recorded songs*; and that said receiving the implementations of the project from the members further includes *posting recorded versions of the sheet music on the website.*

Sherman et al. (Sherman) teaches a method and system for customizing a motion film selection, wherein a movie clip including a soundtrack and music score

[0027] – [0028] are downloaded via the Internet so that participants can record their own versions of soundtracks and submit them to a website for further distribution [0038].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include that said posted artistic works include audio-recorded songs, as disclosed in Sherman, because it would advantageously increase the application field of the Narang's invention, thereby increase revenue.

Information as to *a musical show; the written sheet music including words; and a singer* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Narang in view of Sherman would be performed the same regardless of the type of the musical work, content of the musical scores, and if a member is a singer, or not.

Claim 10. Narang teaches said method and system for creation of artistic works over a computer network, comprising: posting artistic works, including screenplays, plays and musical scores for musical works on the Internet; receiving the implementations of the project from the members [0007]; [0009].

Narang does not specifically teach that said posted artistic works include audio-recorded songs.

Sherman teaches said method and system for customizing a motion film selection, wherein a movie clip including a soundtrack and music score [0027] – [0028] are downloaded via the Internet so that participants can record their own versions of soundtracks and submit them to a website for further distribution [0038].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang to include that said posted artistic works include

audio-recorded songs, as disclosed in Sherman, because it would advantageously increase the application field of the Narang's invention, thereby increase revenue.

Information as to *at least two audio-recorded e-audition songs* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).*

Claim 15. Narang teaches said system, including: an Internet website and a voting counter [0007]; [0009]; [0036].

Claim 16. Narang teaches said system, including a display [0017] (browsing the Internet obviously indicates use of a display). Information as to *display of voting data* is non-functional language and not given patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 16 including *a display* are disclosed in Narang as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 17. Narang teaches said system including the display [0017] (browsing the Internet obviously indicates use of a display). Information as to *the display for showing a numerical-vote; a percentage-of-the-vote; or both* is non-functional language and not given patentable weight. Claims Directed to an Apparatus must be distinguished from the prior art in terms of structure rather than function, *In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959).

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (bd Pat. App. & Inter. 1987). Thus the structural limitations of claim 17 including *a display* are disclosed in Narang as described herein. Also as described the limitations of the claim do not distinguish the claimed apparatus from the prior art.

Claim 21. Narang teaches said system, including: posting artistic works, including screenplays, plays and musical scores for musical works on the Internet [0007]; [0009]. Information as to *the musical show is Worlds Away Musical* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Narang in view of Sherman would be performed the same regardless of the type of the musical work.

Claim 22. Narang teaches said system, including: posting artistic works, including screenplays, plays and musical scores for musical works on the Internet [0007]; [0009]. Information as to *the website is www.WorldsAwayMusical.com* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Narang in view of Sherman would be performed the same regardless of the type of the website.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Sherman and further view of Miles et al. (US 6,102,406).

Claim 5. Narang in view of Sherman teach all the limitations of claim 5, except that when the musical work is printed onto the paper, the website domain name is printed onto the paper.

Miles et al. (hereinafter Miles) teaches a method and method for Internet-based advertising scheme, wherein any print out of a Web page will automatically include a domain name (C. 7, L. 19-23).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang in view of Sherman to include printing a domain name on the Web page print out, as disclosed in Miles, because it would advantageously promote a name of the Web page content provider.

Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Narang in view of Sherman and further in view of Ghani (US 2002/0085030 A1).

Claim 20. Narang in view of Sherman teach all the limitations of claim 20, expect teaching identifying each received recorded version with public identifying information as specified by the submitter of the recorded version.

Ghani teaches a method and system for a graphical user interface (GUI) for an interactive collaboration system, said GUI includes a comment box within which a posted messages are displayed, and an audience text box within which a list identifying each participant is displayed [0007].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Narang in view of Sherman to include posting next to a received recorded version public identifying information, as disclosed in Ghani, because it would advantageously allow the participants to identify individuals providing useful information and, further, contact them.

Response to Arguments

Applicant's arguments filed 7/30/2004 have been fully considered but they are not persuasive.

In response to applicant's argument's that Narang fails to disclose *musical show* and *written sheet music for the musical show, with the written sheet music including words,* it is noted that Narang teaches: posting artistic works, including screenplays, plays and musical scores for musical works on the Internet; [0007]; [0009]. Information as to *musical show* and *the written sheet music including words* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Narang in view of Sherman would be performed the same regardless of the *type* of the artistic works or *content* of the musical scores.

In response to applicant's argument's that Narang fails to show receiving recorded versions of the sheet music by a *singer,* it is noted that Sherman teaches recording their own versions of soundtracks by participants and submit them to a Web site [0038]. Information as to *a singer* is non-functional language and not given patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The method steps, disclosed in Narang in view of Sherman would be performed the same regardless if participants are singers, or not.

In response to applicant's argument's that Narang fails to show posting recorded versions, the examiner points out that Sherman was applied to show that participants record their own versions of soundtracks and submit them to a Web site [0038].

In response to applicant's argument's that the prior art does not *solve the problem of how to interest people besides the creators in the musical score,* it is noted that said feature, upon which applicant relies in claim 5, is not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As per claim 5, Miles was applied to show printing the website domain name form the Internet (C. 7, L. 19-23).

As per claim 20, in response to applicant's argument's that the prior art does not teach *identifying each received recorded version with public identifying information as specified by the submitter of the recorded version*, it is noted that Ghani was applied for this feature. Specifically, Ghani teaches providing a comment box within which a posted messages are displayed, and an audience text box within which a list identifying each participant is displayed [0007].

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308- 2702.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

(703) 305-7687 [Official communications; including After Final communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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10/08/2004